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HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450, ON THE DATE INDICATED BELOW.

BY: Gene Conto Date: August 30, 2004

**MAIL STOP AMENDMENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Patent Application of:	:	
Shinichi Shirahama et al.	:	
Conf. No.: 4470	:	Group Art Unit: 1764
Appln. No.: 10/800,949	:	Examiner: Jerry D. Johnson
	:	ATTN: SUSAN S. HAY,
	:	LEGAL INSTRUMENTS EXAMINER
Filing Date: March 15, 2004	:	Attorney Docket No.: 8305-239US (NP149-1)
Title: LUBRICATING OIL COMPOSITION FOR INTERNAL COMBUSTION ENGINE	:	

**RESPONSE TO NOTICE OF NON-COMPLIANT  
AMENDMENT UNDER 37 C.F.R. 1.121**

This is in response to the Notice of Non-Compliant Amendment under 37 C.F.R. 1.121 (copy enclosed). This response is being timely filed on August 30, 2004 (August 29 being a Sunday).

The Notice states that the amendments to the claims have not been provided with proper status identifiers and that claims 1-8 need to have the status identifier on them. This objection and requirement are respectfully but strenuously traversed for the reasons set forth in detail below.

The Amendment in question, filed with the original application on March 15, 2004, is a Substitute Specification. That is, it is an Amendment under 37 C.F.R. § 1.125, not an Amendment under 37 C.F.R. § 1.121. Therefore, the Notice of Non-Compliance under 37 C.F.R. § 1.121 is not applicable to the present Amendment.

Further, Applicants can find no requirement in 37 C.F.R. § 1.125 for the use of status identifiers. In fact, when 37 C.F.R. § 1.121 became effective on June 30, 2003, the Patent Office

Application No. 10/800,949  
Reply to Notice of Non-Compliant Amendment

stated that the practice with respect to Substitute Specifications would not change. The firm of the undersigned has filed dozens of Substitute Specifications in the past year, and this is the first time that the Patent Office has ever required status identifiers for the Substitute Specification.

Accordingly, it is believed that no status identifiers are required under the rules, and reconsideration and withdrawal of the Notice of Non-Compliant Amendment are respectfully requested.

Respectfully submitted,

Shinichi Shirahama et al.

August 30, 2004 By: William W. Schwarze  
(Date)

**WILLIAM W. SCHWARZE**

Registration No. 25,918

**AKIN GUMP STRAUSS HAUER & FELD LLP**

One Commerce Square

2005 Market Street, Suite 2200

Philadelphia, PA 19103-7013

Telephone: 215-965-1200

**Direct Dial: 215-965-1270**

Facsimile: 215-965-1210

E-Mail: [wschwarze@akingump.com](mailto:wschwarze@akingump.com)

WWS:rc

Enclosure: Copy of Notice of Non-Compliant Amendment



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,949	03/15/2004	Shinichi Shirahama	8305-239US (NP149-1)	4470

570 7590 07/29/2004

AKIN GUMP STRAUSS HAUER & FELD L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103-7013



EXAMINER

JOHNSON, JERRY D

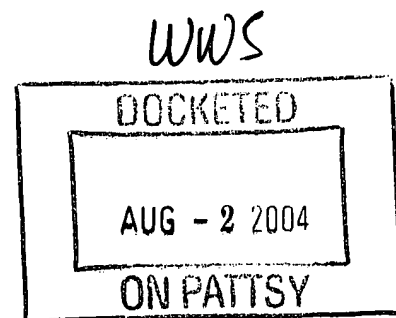
ART UNIT PAPER NUMBER

1764

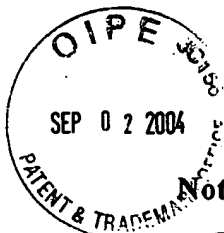
DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AUG - 2 2004



DEADLINE: 8/29/04



10/800949

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Paper No.

## Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on 3-15-04 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following item(s) is required. Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted. 37 CFR 1.121(h).

## THE FOLLOWING CHECKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_
- ☐ 3. Amendments to the drawings: \_\_\_\_\_
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all claims (including withdrawn claims)
  - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☒ E. Other: Claims 1-8 needs the status identifier on them

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT**, applicant is given **ONE MONTH** from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and this **ONE MONTH** time limit is not extendable.

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION** (including a submission for an RCE), and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a **TIME PERIOD** of **ONE MONTH** from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION**, this form may be an attachment to an Advisory Action. The period for response to a final rejection continues to run from the date set in the final rejection, and is not affected by the non-compliant status of the amendment.

Susan A. Hay  
Legal Instruments Examiner (LIE)(571) 272-1017  
Telephone No.